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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,787	12/26/2001	Robert H. China	679.0038USU	7192

7590 06/15/2005

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EXAMINER

MITCHELL, GREGORY W

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,787

Applicant(s)

CHINA ET AL.

Examiner

Gregory W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 9-12, 14-18 and 22-39 is/are pending in the application.
- 4a) Of the above claim(s) 26-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9-12, 14-18 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the Remarks, Amendments and RCE filed April 04, 2005. Claims 1, 14-18 and 22-25 have been amended. Claims 5, 8, 13 and 19-21 have been cancelled. Claims 1-4, 6-7, 9-12, 14-18 and 22-39 are pending. Claims 26-39 have been withdrawn from consideration as being directed to a non-elected invention. Claims 1-4, 6-7, 9-12, 14-18 and 22-25 are examined herein.

Applicant's arguments regarding the 35 USC 112 and 103 rejections of the Office Action dated July 01, 2004 are persuasive. Said rejections are hereby withdrawn. The following rejections now apply.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 04, 2005 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-7, 9-12, 14-18 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura et al. (USPN 6428795) in view of Kellner et al. (USPN 6042815).

Miura et al. teaches spherical powders of organopolysiloxane elastomers having JISA hardness values of 1-30, preferably 1-10 for use in external use compositions (col. 2, lines 41-45). The elastomer is prepared by blending polydimethylsiloxane having dimethylvinylsiloxy groups at both ends of the molecular chain, dimethylsiloxane methylhydrogensiloxane copolymer having trimethylsiloxy groups at both ends of the molecular chain, dimethylpolysiloxane having trimethylsiloxy groups at both ends of the chain and an isopropanol solution containing platonic chloride (col. 8, lines 14-24). The external use compositions are taught to optionally comprise zinc oxide, titanium oxide, precipitated calcium carbonate, nylon powder, polyethylene powder, etc. (col. 4, lines 31-56). The external use composition is disclosed as being formulated as a pressed powder (col. 14, line 55-col. 15, line 31). The spherical powder is capable of being used in an external use composition imparting no sticky sensation while exhibiting excellent retention on the skin (col. 1, lines 46-52).

Miura et al. does not specifically express the use of a silicone elastomer nor does Miura et al. specifically disclose the preferred JISA value, hardness value or percent recovery.

Kellner et al. teaches the combination of an organopolysiloxane having unsaturated groups such as vinyl or allyl, preferably bonded to another Si atom, and

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another silicon compound capable of participating in the addition reaction, for example an organohydrogenpolysiloxane, is recognized in the art as producing a silicone elastomer (col. 8, lines 6-23). Accordingly, the skilled artisan would have recognized the organopolysiloxane elastomers of Miura et al. as falling within the genus of a "silicone elastomer".

It would have been obvious to one of ordinary skill in the art to prepare a pressed powder utilizing an elastomer with a JISA value within the claimed range because Miura et al. teaches the use of such elastomers with a range overlapping with those as instantly claimed. Furthermore, it is well established that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). One would have been motivated to prepare a pressed powder utilizing an elastomer with a JISA value within the claimed range because of an expectation of similar success in preparing a spherical powder capable of being used in an external use composition imparting no sticky sensation and exhibiting excellent retention on the skin, as taught by Miura et al.

It is noted that the claimed hardness values and percent recovery values of the elastomers are properties of said elastomers. Accordingly, since the elastomers taught by the combined references is the same as those claimed, it is Examiner's position that, absent evidence to the contrary, the composition taught by the combined references will possess the same properties as instantly claimed. A product and its properties are inseparable. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER